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09/125,700	10/23/1998	THOMAS FUHRMANN	200-008181-U	8084

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NOKIA, INC.
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EXAMINER

CHIANG, JACK

ART UNIT

PAPER NUMBER

2642

26

DATE MAILED: 08/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/125700

Applicant(s)

Fuhrmann ET AL.

Examiner

J. Chiang

Group Art Unit

2642

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—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE -3- MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 6-9-03.
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-9, 11-13, 15-17 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-9, 11-13, 15-17 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____.

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of References Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

RESTRICTION

1. The restriction dated on 12-13-02 is made final.

NOTE: Fig. 6 and its description filed on 10-09-02 have not been entered (see the argument section below).

CLAIMS

New 112 First Paragraph Rejection

2. Claim 6 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 6 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In claim 6, it claims "... a user may exchange covers easily without the use of a special tool". This is questionable. In the original disclosure, page 7, it states to use "a pointed object", in page 10, it states "the front housing is mated to the rear housing and the two are screwed together with screws 43". It is not seen that it is not using "a special tool". Therefore, the claim is considered unenabling and a new matter.

112 First Paragraph Rejection (Fig. 6 is not entered)

3. Claims 1-17 (drawn to fig. 5) are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In claims 1, 15-17, they all claim a press-on catch. The original claims (1-14), the original Fig. 5 (it shows screws 43), and the original specification do not have a press-on catch for the phone structure itself. It uses screws 43, not press-on catch. Therefore, it is a new matter.

Art Rejection

102 Rejection (Fig. 6 is not entered)

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-9, 11-12, 15-17 are rejected under 35 U.S.C. 102(e) as being anticipated by Kobayashi et al. (US 5722055).

Regarding claim 1, Kobayashi shows:

A first housing (23);

A second housing (25 or 28) user releasably attachable to the first housing (23), the second housing (25 or 28) modifies the external appearance of the phone to the personal tastes (25 or 28) of the user;

At least one key unit (24);

At least one key sensor (41, 42);

Retaining means (22) comprising a cover (i.e. 43) for holding the electronic components (in 22) to the first housing (23, see 54 in fig. 33) when the second housing (25) is released from the first housing (23) by the user, the key unit (24) is free to move when the second housing (25) is released (see 50-51).

Regarding claim 15, Kobayashi shows:

A back housing (23);

At least one key unit (24);

At least one key sensor (41, 42);

A front housing (25 or 28) for modifying the external appearance of the phone to the personal tastes (25 or 28) of the user;

At least one opening (see 25-1-7-1);

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Retaining means (22) comprising a cover (i.e. 43) for holding the electronic components (in 22) to the back housing (23, see 54 in fig. 33) when the front housing (25) is released from the back housing (23) by the user; the key unit (24) is held between the front and back housings (25, 23), and is free to move when the front housing (25) is released (see 50-51).

Regarding claim 16, Kobayashi shows:

A first housing (23);

A second housing (25 or 28) for modifying the external appearance of the phone to the personal tastes (25 or 28) of the user;

At least one key unit (24);

At least one key sensor (41, 42);

Retaining means (22) comprising a cover (i.e. 43) for holding the electronic components (in 22) to the first housing (23, see 54 in fig. 33) when the second housing (25) is released from the first housing (23) by the user, the key unit (24) is sandwiched between the front and back housings (25, 23), and is free to move when the second housing (25) is released (see 50-51).

Regarding claim 17, Kobayashi shows:

A first housing (23);

A second housing (25 or 28) for modifying the external appearance of the phone to the personal tastes (25 or 28) of the user;

Attachment means (50-51);

At least one key unit (24);

At least one key sensor (41, 42);

Retaining means (22) comprising a cover (i.e. 43) for holding the electronic components (in 22) to the first housing (23, see 54 in fig. 33) when the second housing (25) is released from the first housing (23) by the user, the key unit (24) is free to move when the second housing (25) is released (see 50-51).

Regarding claims 2-9, 11-12, the combination of Kobayashi and Semenik shows:

The user interface second housing (25 in Kobayashi);

A circuit board (i.e. 41, 45);

The key sensor (see 41);

The cover, the components and the circuit board (43, 41, 45);

The releasable cover (see 43, 43-4);

The cover aperture (see 43);

A sealing member (i.e. 40);

the first housing (23);

the second housing (25);

the key unit which is a key mat (24); and

the key sensor (41, 42).

6. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kobayashi in view of Takagi et al. (US 523566).

Regarding claim 13, Kobayashi shows the key sensor (41, 42).

Kobayashi differs from the claimed invention in that it does not explicitly mention that the key sensor is a membrane type of key switch.

However, membrane type of key switch is one of the most common type of key switch, this is shown by Takagi (see 10). Hence, if it is found that Kobayashi is not the membrane type of switch, then it would have been obvious for one of ordinary skill in the art to use the membrane type of switch in Kobayashi with/without the teaching of Takagi, because it is a conventional type of switch.

7. The following 103 rejection is drafted to assist applicant to understand the overall cited prior art which potentially cover the claimed material even if Fig. 6 is entered.

103 Rejection (If Fig. 6 is entered)

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-9, 11-12, 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kobayashi et al. (US 5722055) in view of Semenik et al. (US 5233506).

Regarding claim 1, Kobayashi shows:

A first housing (23);

A second housing (25 or 28) user releasably attachable to the first housing (23), the second housing (25 or 28) modifies the external appearance of the phone to the personal tastes (25 or 28) of the user;

At least one key unit (24);

At least one key sensor (41, 42);

Retaining means (22) comprising a cover (i.e. 43) for holding the electronic components (in 22) to the first housing (23, see 54 in fig. 33) when the second housing (25) is released from the first housing (23) by the user, the key unit (24) is free to move when the second housing (25) is released (see 50-51).

Kobayashi differs from the claimed invention in that Kobayashi uses screw to attach the second and first housings together instead of using a press-on/catch.

However, in telephone housing assembly, it is commonly seen that a press-on/catch is used to attach a first and a second housing together. This is shown by Semenik (100, 200; or 500, 600). Hence, it would have been obvious for one skilled in the art to modify Kobayashi with a press-on/catch when assembling the first and second housings as taught by Semenik, because it is understood that cell phones are getting smaller, this is including reduction in size and mechanical structures, and such press-on/catch shown by Semenik achieves the function of attaching the housings together and yet to reduced dimensions (col. 1, lines 42-50, col. 2, lines 41-47 in Semenik).

Regarding claim 15, Kobayashi shows:

A back housing (23);

At least one key unit (24);

At least one key sensor (41, 42);

A front housing (25 or 28) for modifying the external appearance of the phone to the personal tastes (25 or 28) of the user;

At least one opening (see 25-1-7-1);

Retaining means (22) comprising a cover (i.e. 43) for holding the electronic components (in 22) to the back housing (23, see 54 in fig. 33) when the front housing (25) is released from the back housing (23) by the user;

the key unit (24) is held between the front and back housings (25, 23), and is free to move when the front housing (25) is released (see 50-51).

Kobayashi differs from the claimed invention in that Kobayashi uses screw to attach the second and first housings together instead of using a press-on/catch.

However, in telephone housing assembly, it is commonly seen that a press-on/catch is used to attach a first and a second housing together. This is shown by Semenik (100, 200; or 500, 600). Hence, it would have been obvious for one skilled in the art to modify Kobayashi with a press-on/catch when assembling the first and second housings as taught by Semenik, because it is understood that cell phones are getting smaller, this is including reduction in size and mechanical structures, and such press-on/catch shown by Semenik achieves the function of attaching the housings together and yet to reduced dimensions (col. 1, lines 42-50, col. 2, lines 41-47 in Semenik).

Regarding claim 16, Kobayashi shows:

A first housing (23);

A second housing (25 or 28) for modifying the external appearance of the phone to the personal tastes (25 or 28) of the user;

At least one key unit (24);

At least one key sensor (41, 42);

Retaining means (22) comprising a cover (i.e. 43) for holding the electronic components (in 22) to the first housing (23, see 54 in fig. 33) when the second housing (25) is released from the first housing (23) by the user, the key unit (24) is sandwiched between the front and back housings (25, 23), and is free to move when the second housing (25) is released (see 50-51).

Kobayashi differs from the claimed invention in that Kobayashi uses screw to attach the second and first housings together instead of using a press-on/catch.

However, in telephone housing assembly, it is commonly seen that a press-on/catch is used to attach a first and a second housing together. This is shown by Semenik (100, 200; or 500, 600). Hence, it would have been obvious for one skilled in the art to modify Kobayashi with a press-on/catch when assembling the first and second housings as taught by Semenik, because it is understood that cell phones are getting smaller, this is including reduction in size and mechanical structures, and such press-on/catch shown by Semenik achieves the function of attaching the housings together and yet to reduced dimensions (col. 1, lines 42-50, col. 2, lines 41-47 in Semenik).

Regarding claim 17, Kobayashi shows:

A first housing (23);

A second housing (25 or 28) for modifying the external appearance of the phone to the personal tastes (25 or 28) of the user;

Attachment means (50-51);

At least one key unit (24);

At least one key sensor (41, 42);

Retaining means (22) comprising a cover (i.e. 43) for holding the electronic components (in 22) to the first housing (23, see 54 in fig. 33) when the second housing (25) is released from the first housing (23) by the user, the key unit (24) is free to move when the second housing (25) is released (see 50-51).

Kobayashi differs from the claimed invention in that Kobayashi uses screw to attach the second and first housings together instead of using a press-on/catch.

However, in telephone housing assembly, it is commonly seen that a press-on/catch is used to attach a first and a second housing together. This is shown by Semenik (100, 200; or 500, 600). Hence, it would have been obvious for one skilled in the art to modify Kobayashi with a press-on/catch when assembling the first and second housings as taught by Semenik, because it is understood that cell phones are getting smaller, this is including reduction in size and mechanical structures, and such press-on/catch shown by Semenik achieves the function of attaching the housings together and yet to reduced dimensions (col. 1, lines 42-50, col. 2, lines 41-47 in Semenik).

Regarding claims 2-9, 11-12, the combination of Kobayashi and Semenik shows:

The user interface second housing (25 in Kobayashi);

A circuit board (i.e. 41, 45);

The key sensor (see 41);

The cover, the components and the circuit board (43, 41, 45);

The releasable cover (see 43, 43-4);

The cover aperture (see 43);

A sealing member (i.e. 40);

the first housing (23);

the second housing (25);

the key unit which is a key mat (24); and

the key sensor (41, 42).

10. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Kobayashi and Semenik in view of Takagi et al. (US 523566).

Regarding claim 13, the combination of Kobayashi shows the key sensor (41, 42).

Kobayashi differs from the claimed invention in that it does not explicitly mention that the key sensor is a membrane type of key switch.

However, membrane type of key switch is one of the most common type of key switch, this is shown by Takagi (see 10). Hence, if it is found that Kobayashi is not the membrane type of switch, then it would have been obvious for one of ordinary skill in

the art to use the membrane type of switch in Kobayashi with/without the teaching of Takagi, because it is a conventional type of switch.

ARGUMENT

11. In response to the remarks (pages 8-15), in pages 8-10, in arguing the “press-on catch”, applicant cited various portions of WO 97/32424, a few law cases and section of the 112 first paragraph requirement. First, the “press-on catch” in WO 97/32424 is used to fasten an external wall to a front housing of the device, it is not even used to fasten a front and a back housing as claims 1-17. This description is fig. 1 of the present application and it is directed to the non-elected claims 18-24. The present claims 1-17 are directed to fig. 5. In other words, this portion of the disclosure is not a support for the change in Fig. 6 and its description. Second, even there is a feature disclosed in one embodiment, that does not mean this feature can be placed in any part of the device to create a newly added embodiment in supplemental papers in the same application. For example, there is a **display** in the **front** of the device, and it is surely that it is enabling, but that does not allow applicant to add an new embodiment by putting the display on the **back** of the device in supplemental papers in the same application. The examiner is not saying that one skilled in the art would need to use undue experimentation to practice the invention, the examiner is saying that it is new and not supported by the original disclosure. Third, after removing screws 43 in fig. 5, what element(s) secure housings (18-19) together, and where is the original support for such change if screws 43 are not used?

In pages 11-12, applicant cited some languages in claims 1, 3, 5, 6, 10 to support his argument about the newly added "press-on catch" feature. The examiner just can not find the "press-on catch" feature in any of the claims mentioned above. Those claims have the claimed language of "housing is released from attachment", this language is supported when screws are used in the original disclosure. Does the use of screws not meet the claimed "housing is released from attachment"?

In pages 12-14, applicant cited the retaining frame 35, the circuit board 23, screw 39, the spring clips. These are the mounting of the frame with the cover, there is not about the "press-on catch" for fastening the front and the back covers together.

In bottom of page 14, applicant argues that nowhere in Kobayashi ... teaching of a user-replaceable housing to modify the external appearance of a radiotelephone by the end-user to suit his or her's personal tastes.... The examiner disagrees. In Kobayashi's fig. 1, it shows two different covers, elements 25 and 28, either one of the covers (25, 28) can be attached to the back cover by using screws. It is not seen why Kobayashi does not teach of a user-replaceable housing to modify the external appearance of a radiotelephone by the end-user to suit his or her's personal tastes.

In conclusion, it is believed that the claimed covers are met by Kobayashi and Semenik.

12. Applicant's arguments with respect to claims 1-9, 11-13, 15-24 have been considered but are moot in view of the new ground(s) of rejection.

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

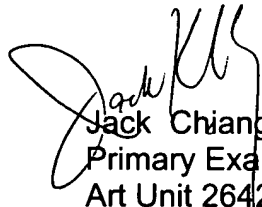
§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jack Chiang whose telephone number is 703-305-4728. The examiner can normally be reached on Mon.-Fri. from 8:00 to 6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Admad Matar, can be reached on (703) 305-4731. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9314.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4700.


Jack Chiang
Primary Examiner
Art Unit 2642